

REMARKS

Claims 8 to 11 and 15 are canceled without prejudice, and therefore claims 12 to 14 and 16 to 19 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph twelve (12) of the Office Action, Applicants thank the Examiner for indicating that claims 18 and 19 include allowable subject matter. While the objections may not be agreed with, to facilitate matters, claims 18 and 19 have been rewritten to include the features of their respective base claims. Additionally, claims 12 to 14 now depend from claim 19, since claim 11 is canceled without prejudice. Also, claims 16 and 17 now depend from claim 18, since claim 15 is canceled without prejudice. Accordingly, claims 12 to 14 and 16 to 19 are allowable.

As asserted, claims 8 and 9 were rejected under 35 U.S.C. § 102(b) as anticipated by the “admitted prior art”.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Regardless of the proper characterization of the prior art, to facilitate matters, claims 8 and 9 have been canceled without prejudice in view of the amendments to claims 18 and 19, which contain allowable subject matter.

It is therefore respectfully requested that the anticipation rejections be withdrawn as moot.

Claims 11 to 17 were rejected under 35 U.S.C. § 103(a) as obvious over Sarangapani, U.S. Patent No. 6,055,042, and Anderson et al., U.S. Patent No. 6,853,908.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with and as explained above, to facilitate matters, claims 18 and 19 have been rewritten to include the features of their respective base claims. Additionally, claims 12 to 14 now depend from allowable claim 19, since claim 11 is canceled without prejudice. Also, claims 16 and 17 now depend from allowable claim 18, since claim 15 is canceled without prejudice. Accordingly, claims 12 to 14 and 16 to 19 are allowable.

Accordingly, as presented, claims 12 to 14 and 16 to 19 are allowable. It is therefore respectfully requested that the obviousness rejections be withdrawn.

Accordingly, claims 12 to 14 and 16 to 19 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 12 to 14 and 16 to 19 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

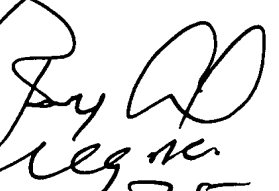
Dated: 7/6/2007

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